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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,022	06/19/2003	Rikard M. Kjellberg	3399P102	7089

26529 · 7590 06/28/2005

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EXAMINER
STEIN, JULIE E

ART UNIT	PAPER NUMBER
2685	

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/601,022	KJELLBERG ET AL.
	Examiner	Art Unit	
	Julie E. Stein, Esq.	2685	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-30* is/are pending in the application.
      4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) *1-30* is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☐ All b) ☐ Some * c) ☐ None of:
       1. ☐ Certified copies of the priority documents have been received.
       2. ☐ Certified copies of the priority documents have been received in Application No. _____.
       3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
          application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date *10-28-03*.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

REQUEST FOR ADDITIONAL INFORMATION

1.   It has come to the Examiner's attention that a co-pending application[1],

10/600746, in which an IDS was filed on November 22, 2004, contained prior art of

interest in the current/pending application. Specifically, the Ellipsus White Paper of

2/12/01. In view of the inability of the Examiner to obtain any additional Ellipsus

information, as the company has been acquired by the current assignee, Openwave

Systems Inc., the Examiner is requesting any additional information that Applicants may

have access to that would be material to the examination of this application. Applicants'

cooperation is greatly appreciated.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3.   Claims 1-6, 9-10, 14-19, and 23-30 are rejected under 35 U.S.C. 102(b) as being

anticipated by Ellipsus White Paper – InfiniteMAP, dated February 12, 2001 (Ellipsus).

The Examiner has included a copy of "GPRS-Applicability and Expectations" by Erik

Bladh and Anna Eidegard, not as prior art, but simply as containing a clean version on

page 28 of the figure on page 3 of Ellipsus.

Independent claims 1, 14, 23, 24, and 30 are all disclosed by Ellipsus.

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[1] This application has not been cross-referenced in the pending application.

Claims 1 and 3 recite, a method of providing access to content for use on wireless communication devices (page 1), the method comprising: operating a server system (page 3, Figure, InfiniteMAP Architecture) to store domain data describing a plurality of domains (page 3, Figure, cylinder in integration components section, it is inherent that there would be multiple domains based on different devices capabilities and user profiles) each domain representing a different subset of a plurality of wireless services subscribers (Id.); operating the server system to enable a plurality of content suppliers (page 3, Figure, product provider in API users box and page 4, product provider interface) to publish content on the server system via a computer network such that the content is accessible to the plurality of wireless services subscribers (Id.); and operating the server system to enable subscribers in each of the plurality of domains to acquire the content via at least one wireless network and to use the content on associated wireless communication devices (page 4).

The rejection of claim 1 is hereby incorporated. Claims 2 and 14 recite, a method comprising: maintaining, in a server system (see above), data defining a plurality of domains (see above), each of the domains representing a billing relationship between a business entity and a particular subset of a plurality of wireless services subscribers (page 3, Figure, Billing System in Integration Components); enabling a plurality of digital product providers to publish digital products on the server system (see above); enabling each of the subscribers to view descriptions of the digital products and to request the digital products from the server system (see above); and provisioning the

requested digital products in wireless communications devices of the subscribers via at least one wireless network (see above).

The rejections of claims 1 and 14 are hereby incorporated. Claim 23 recites, a system comprising: means for maintaining an association between each of a plurality of subscribers of wireless services and one of a plurality of domains into which the plurality of subscribers are grouped (see above), each domain representing a group of the wireless services subscribers and including a different subset of the plurality of subscribers (see above); and means for managing publication, management and delivery of digital content by a plurality of content suppliers to the subscribers in each of the plurality of domains (see above).

The rejections of claims 1, 14, and 23 are hereby incorporated. Claims 19 and 24 recite, a system to provide digital content from a plurality of digital content providers to a plurality of wireless services subscribers using a plurality of wireless communications devices (see above), the system comprising: a domain manager to maintain an association between each of the subscribers and one of a plurality of domains into which the plurality of subscribers are grouped (see above), each domain representing a different subset of the plurality of subscribers (Id.); a product manager to manage publication of digital content to a wireless communications device of a requesting subscriber via a wireless network in conjunction with a received request for the item of digital content (see above); and a payment manager to execute a payment process for charging the requesting subscriber for the item of digital content (page 3, Figure, Billing System).

The rejections of claims 1, 14, 23, and 24 are hereby incorporated. Claims 9-10,

16-18, 25-26, and 30 recite, a system to manage publication and delivery of digital

content to users of a plurality of wireless communications devices operating on a

wireless network (page 3, Figure 3, right side of figure), the users being wireless

services subscribers (see above), the plurality of wireless client devices being

registered to and operable by the users to access the wireless services (inherent based

on above), the system comprising: a domain manager to maintain data defining an

association between each of the subscribers and one of a plurality of domains into

which the subscribers are grouped (see above), each domain defined as a group of the

wireless services subscribers and including a different subset of the plurality of

subscribers (see above), each of the domains representing a billing relationship

between a business entity and a particular subset of the plurality of subscribers (see

above), wherein each subscriber is a member of exactly one of the domains (this is

inherent based on each mobile user/phone/PDA/etc. is unique and thus would only fit in

one subset); a set of protocol handlers (page 3, Figure, provisioning workflow,

specifically WAP, Web, XML), each protocol handler to enable the system to

communicate with wireless client devices over at least one wireless network using a

separate associated protocol (Id.); a product manager to manage submission and

publication of digital content by a plurality of content suppliers (page 3, Figure, API),

wherein the product manager includes a product catalog containing descriptions of

available digital content (page 4), and a pricing manager to determine and indicate a

price for an item of digital content in response to a signal from a wireless

communications device of the plurality of wireless communications devices (see above),

wherein the price is determined according to a domain in which a requesting subscriber

is included (see above); a delivery manager to manage delivery of the item of digital

content to the mobile client device via at least one wireless network in conjunction with

a received request for the item of digital content (see above); and a payment manager

to execute a payment process for charging the requesting subscriber for rights to use

the item of digital content (see above).

Ellipsus also discloses all the steps of claims 4-6 and 27-29, including wherein

each of the domains represents a billing relationship between a business entity and a

particular subset of the plurality of subscribers (see above); each of the subscribers is a

member of exactly one of the domains (see above); the plurality of domains represents

a partitioning of the content for purposes of making the content available to the

subscribers (page 3, context manager); and the plurality of domains further represents a

delegation of administrative responsibilities for the content and the subscribers (this is

inherent based on the various types of phones/PDAs/mobile devices).

Ellipsus also discloses all the steps of claim 15, including wherein said

maintaining data defining a plurality of domains comprises maintaining, in the server

system data defining an association between each of the subscribers and one of the

domains. See page 3, Figure and the context manager and the integration

components.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

6.   Claims 7-8, 11-13, and 20-22 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Ellipsus in view of U.S. Patent Application Publication No.

2001/0037192 to Shimamoto et al.

Ellipsus teaches all the steps of claim 8, 12, and 21, except determining the

language used within each domain. However, Shimamoto teaches that language is one

factor to be considered when determining/publishing data to wireless subscribers. See

Figure 3, paragraphs 64 and 14. Therefore, it would have been obvious to one of

ordinary skill in the art at the time the invention was made, to modify the method of

Ellipsus to take into consideration the language of the wireless subscribers as it is yet

another part of the user profile and device capabilities already used by Ellipsus to

identify users.

Ellipsus teaches all the steps of claims 7, 11, and 20, except currency for billing

purposes for each domain. However, Shimamoto teaches that in addition to language,

pricing should also be taken into consideration. See paragraph 15. Therefore, it would

have been obvious to one of ordinary skill in the art at the time the invention was made,

to modify Ellipsus to take into consideration the currency of the wireless subscribers in

view of the language they speak that their user profiles indicate, as yet this would be

another addition to their user profile and further identify the user.

The rejections of claims 7-8, 11-12, and 20-21 are hereby incorporated. Ellipsus

in view of Shimamoto teaches all the steps of claims 13 and 22, including, the language

and currency determinations for the domains.

Double Patenting

7.   The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11
F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225
USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA
1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*,
418 F.2d 528, 163 USPQ 644 (CCPA 1969).
        A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be
used to overcome an actual or provisional rejection based on a nonstatutory double
patenting ground provided the conflicting application or patent is shown to be commonly
owned with this application. See 37 CFR 1.130(b).
        Effective January 1, 1994, a registered attorney or agent of record may sign a
terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with
37 CFR 3.73(b).

8.   Claims 1-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10/600,746. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application are broader versions of the currently pending claims and therefore the current claims could be used to reject them.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

9.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 6,161,140 to Moriya teaches an information transfer system between a data terminal and a central facility.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie E. Stein, Esq. whose telephone number is (571) 272-7897. The examiner can normally be reached on M-F (8:30 am-5:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on (571) 272-7899. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

JES

6/ 24/2005

NGUYEN T. VO
PRIMARY EXAMINER